



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

05/12/97

05/08/97

DURN

H

BAYER9265.1K

EXAMINER

HM42/0811

KURT G. BRISCOE
SPRUNG KRAMER SCHAEFER & BRISCOE
660 WHITE PLAINS ROAD
TARRYTOWN NY 10591-5144

ROBINSON, A

ART UNIT

PAPER NUMBER

1616

20

DATE MAILED: 08/11/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5-26-98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 5, 11, 12, 15 and 16 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 5, 11, 12, 15 and 16 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892 _____
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413 _____
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1616

Claims 5, 11, 12, 15 and 16 are acted upon on their merits to the extent that they read on the elected invention. See paper number 17 of the instant application and paper number 6 of parent application 08/440,428 wherein the specific compound imidoclopid was elected. The claims read on a multitude of active compounds that are so non-related to each other and so different that they can clearly support separate patents. Therefore, the restriction requirement is deemed proper and adhered to. Cancellation of non-elected claims and subject matter from other claims is now required.

Claims 5, 11, 12, 15 and 16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kristiansen et al. (A), Shiokawa et al. (B), Elbert et al. (AT) and Derwent Abstract of JP 03,279,389 (AR"), all of record and for reasons of record as set forth in paper number 17, page 3, regarding the rejection of claims 2-5 and 10-12. Applicants' arguments have been carefully considered; however, they are not deemed persuasive. The prior art teaches that the claim designated pyridinylomethyl-imidazolidinium compounds are effective against insects of the type claimed and applied to the same locus of the claims, i.e. environment. For example, see the Shiokawa et al. reference, col.4 lines 62-67, wherein the active compounds can be applied to warm-blooded animals in the hygiene field. Clearly this is the same locus of the instant claims. Thus, no patentable distinction can be seen between the claims of record and the state of the art as taught by the prior art. With regard to the second Dr. Hubert Dorn declaration, dated April 7, 1997, said declaration is not of record in the instant application.

Art Unit: 1616

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Robinson whose telephone number is (703) 308-4524.

AJR
August 10, 1998


ALLEN J. ROBINSON
PRIMARY EXAMINER
GROUP 1200